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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,533	09/19/2006	Shinichi Ogasawara	SCEP 22.456(100809-00319)	5458
26304 7590 02/25/2010 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER DEODHAR, OMKAR A				
ART UNIT 3714		PAPER NUMBER		
MAIL DATE 02/25/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,533

**Applicant(s)**

OGASAWARA ET AL.

**Examiner**

OMKAR A. DEODHAR

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.5-14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)  
Paper No(s)/Mail Date 11/6/2009

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Final Rejection**

#### ***Response to Amendment & Arguments***

The majority of Applicant's arguments (& amendment) are directed towards the intended usage of the claimed invention. For instance, regarding the amendment to claim 1, Applicant argues that the claimed button on the extended line of the curve on both sides of the casing is for operation by a user's index finger. It is immaterial which finger is used to control these buttons. Nevertheless, the prior art still teaches this feature. See Mical, Fig. 1 showing buttons on the curves of both sides of his portable gaming unit.

Applicant also argues that the prior art fails to teach the presently claimed width of the cross section of the area, on which the operating means are placed, gradually becomes narrower from a nearer side to the center to the left & right sides of the casing at both a display unit face and a rear face. Examiner respectfully disagrees. Applicant's Fig. 1 shows the claimed structure. Mical's Fig. 1 shows a structure with similar features – the casing gradually becomes narrower from a nearer side to the center to the left & right sides of the casing at both the display & rear end. Mical's Fig. 1 makes it readily apparent that the prior art shows a casing equivalent to Applicant's claimed invention.

Regarding the new claim, Applicant argues that the claimed notches on the bottom left & right corners of the casing supports a base of a user's thumb. Mical's Fig. 1, 36 shows a notch for gripping the device. Likewise, a notch appears on the other side of Mical's device. These notches are located towards the bottom rear of the casing.

Based on the foregoing, the rejection is respectfully maintained.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 5-14 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeong (US 6,813,147) in view of Mical (US 4,969,647).**

**Claim 1:** Jeong discloses a portable electronic device, comprising:  
a horizontally long casing, both ends of which are capable of being gripped by a user's both hands, respectively (Figure 1); a display unit fit into the casing (Figure 1); and  
an optical disk drive unit which has a lid opening backwards and on which a detachable optical disk is loaded (Figure 5, movement of Jeong's lid is interpreted as opening backwards with respect to the front of the casing & a user's perspective),  
wherein a planar region is provided at substantially a center of the rear face of the casing, and at least a part of the planar region constitutes the lid of the optical disk drive unit (Figure 5 – part of said planar region constitutes the lid of the disk drive),

Jeong does not teach a button on the curve of both sides of the casing, curved shapes formed symmetrically on both sides of the casing respectively so that fingers of the user gripping the casing placed along the curved shapes make the tips of the fingers point away from the center of the lid of the optical disk drive unit, and wherein a horizontally longitudinal cross section of the casing substantially perpendicular to the rear face comprises the curved shapes having gentle curves slanted such that a width of the cross section of the area, on which the operating means are placed, gradually

becomes narrower from a nearer side to the center to the left & right sides of the casing at both a display unit face and a rear face.

(Mical teaches a hand-held electronic device with curved edges & buttons placed on both sides of the curved edges. See Mical Figure 1. These claim limitations are reflected in Applicant's Fig. 2. A comparison between Applicant's Fig. 2 & Mical's Fig. 1 shows the same structure of a curved shapes having gentle curves slanted such that a width of the cross section of the area on which the operating means are placed gradually becomes narrower from a nearer side to the center to the left and right sides of the casing & both a display & rear face.)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide curved edges, with buttons, as taught by Mical's Figure 1 on Jeong's portable electronic device for the purpose of making it easier for a user to hold. See Mical Col. 1 Lines 53-60 for this motivation. This modification yields highly predictable results because it is desirable to provide devices that are easy to hold. Changes to the prior art utilizing known methods yielding predictable results are considered obvious.)

**Claim 5:** Jeong discloses the portable electronic device of claim 1, further comprising a first operation means (Figure 1, Item 192) and a second operation means (Figure 1, Item 190 provided on the front face of the casing, wherein each of the first operation means and the second operation means is operated by a thumb of the user gripping the casing (A person may use his thumb, or any other finger to press the buttons), the first operation means is a direction instruction key (Figure 1, Item 192

teaches instruction keys) having a plurality of pressed faces each corresponding to an operation direction (Figure 1, Item 192, instruction keys corresponding to an operation direction), the second operation means is a plurality of button keys each outputting single instruction (Figure 1, Items 190 show a plurality of keys for various instructions), and the center of the direction instruction key and the center of the button keys are shifted upward in the vertical direction from the horizontal center line of the casing when viewed from the user (the keys described above are interpreted as teaching the claimed limitations).

**Claim 6:** Jeong discloses the portable electronic device of claim 5, wherein when the casing is placed on a horizontal plane so that a face without the display unit is oriented downward (the bottom of the device is oriented downward), a top of the direction instruction key and a top of any one of the plurality of button keys are higher than the maximum height of the casing (since the keys are elevated with respect to the planar surface they reside on, they are interpreted as being higher than the maximum height of the casing when the optical drive is in its closed position. In this respect, the casing is interpreted as the planar region containing the disk drive & buttons; apart from the display.)

**Claim 7:** Jeong discloses the portable electronic device of claim 5, wherein the front face of the casing comprises at least two areas, the direction instruction key and the plurality of button keys are placed in a first area (Figure 1, Items 190 & 192 are in a first area),

and at least one sub operation button not used during game play going on the display unit is placed in a second area, wherein the height of the first area and the height of the second area are different from each other when measured from a horizontal plane on condition that the casing is placed on the horizontal plane so that a face without the display unit is oriented downward.

(Jeong teaches buttons in a second area. See Figure 1 showing a plurality of sub operation buttons in an area different from buttons 190 & 192 & of a different height. If an interactive disk is used with the system, a game is taught.)

**Claim 8:** Jeong discloses the portable electronic device of claim 7, wherein the second area is elevated from the first area. (See Figure 1, Button 194 is in a first area while Buttons 190/192 are in a second area elevated from the first area.)

**Claim 9:** Jeong discloses the portable electronic device of claim 5, wherein spacing between the pressed surfaces of the direction instruction key and spacing between each button of the button keys are different from each other. (See Figure 1, spacing between directional buttons 192 & buttons 190 is different).

**Claim 10:** Jeong discloses the portable electronic device of claim 5, further comprising an analog operation means for outputting an analog signal for direction (Figure 1, directional buttons 192), wherein the analog operation means is located closer to the user than the direction instruction key and the center of the analog operation means is located inside of the center of the direction instruction key. (Jeong's directional buttons 192 show an operation means located inside of the center of a

direction instruction key. This configuration appears identical to Applicant's control means 20 or 30 as in Fig. 1).

**Claims 11, 12:** Jeong discloses the portable electronic device of claim 1, wherein the surface of the casing is a resin molded part (the device is made of some type of resin).

Jeong's Figure 1 Item 126 discloses a transparent window through which a display can be viewed. However, Jeong does not teach: a transparent window made of a first transparent resin, the frame being made from a second colored resin, wherein the first resin and the second resin are molded in a unified fashion by two-color molding. And additionally, he does not teach a first resin covering the whole frame surface.

Applicant's Specification, Page 8, Paragraph 2 discloses "As the resin materials, polycarbonate resin with shock resistance and transparency is preferable, but other resin such as acrylic may be employed. The transparent window and the frame may be molded in different resin materials from each other."

This is taken as an admission that the type of resin materials used are design considerations. As such, it would have been a matter of obvious design choice to a person of ordinary skill in the art at the time of Applicant's invention to make Jeong's transparent window of a first transparent resin, the frame being made from a second colored resin, wherein the first resin and the second resin are molded in a unified fashion by two-color molding, or even cover the whole frame surface with the first resin.

**Claims 13, 14:** Jeong discloses: The portable electronic device further comprising a speaker within the casing, wherein a through hole is formed at the bottom



face of the casing for emitting sounds generated from the speaker, the through hole being formed with an angle toward the front face of the casing, a second through hole formed in the front face of the casing, and a duct formed inside the casing for directing sounds generated from the speaker to the second through hole.

(Jeong teaches that it is well-known in the art to place speakers at the base of the unit or on the display unit. See Col. 1. Lines 49-50. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to place speakers at the base of the unit as taught by Jeong & provide through holes & sound ducts in the claimed manner. This yields the predictable results of outputting sounds with sufficient volume & clarity.)

**Claim 16:** Jeong discloses the invention substantially as claimed but does not explicitly show notches, or the equivalent at right & left corners of his device. Mical teaches an arrangement equivalent to notches that support a user's gripping of his device at the bottom right & left corners. See Fig 1, 36. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide a means for a user to grip the device, wherein this means is located on the lower right & left hand corners of the device, as taught by Mical in Jeong's device. This yields predictable results.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Omkar Deodhar/

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714